UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,269	06/24/2004	Michael Maguire	555255012760	9824

24325 7590 10/04/2007	EXAMINER
PATENT GROUP 2N	SHEDRICK, CHARLES TERRELL
JONES DAY	
NORTH POINT	

	ART UNIT	PAPER NUMBER
901 LAKESIDE AVENUE	2617	
CLEVELAND, OH 44114		

MAIL DATE	DELIVERY MODE
10/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/500,269	MAGUIRE ET AL.
	Examiner	Art Unit	
	Charles Shedrick	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 July 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 7/20/07 have been fully considered but they are not persuasive.

Applicant argues that *Fujino even though it is clear that Hull is missing the steps of (1)*

identifying the correspondent of a communications event at a mobile device independent of an

address book and then (2) automatically retrieving a communications event history associated

with the identified correspondent, in point of fact, Hull teaches that the prior communications

events are identified as a consequence of identifying the correspondent in the address book. In

this manner, Hull teaches away from the present set of claims and thus the obviousness rejection

is faulty and should be withdrawn.

However, the Examiner respectfully disagree.

The Examiner would also respectfully like to point out that regarding the Applicant's argument

that the steps occur in a particular order (e.g., "and then automatically retrieving) that the claim

language is not explicit regarding a particular order of occurrence. Regarding teaching away a

careful review of Hull paragraph 0019 states that the present invention is directed towards a

method and apparatus that allows a user to quickly and easily determine if any messages have

been received, along with the sender's identity and the relative age of the message.

Paragraph 0041 teaches that a sender identifier is typically included in a header of a received

message.

Paragraph 0046 teaches that if in step 420 mobile electronic communication device 100 (FIG. 1)

determines that none of the stored messages is from a contact, the operational flow proceeds to a

step 421. In step 421, in one embodiment, the message received in step 209 (FIG. 2) is handled

without performing light functions. <u>In one embodiment, mobile electronic communication device</u>

<u>100 is configured to allow the user to access stored messages</u>. For example, processor unit 104

can be programmed to display prompts or menus via display 103 (FIG. 1), which the user can

navigate using keypad 105 (FIG. 1) to view the message received in step 8 (FIG. 1). The contact

list is used as an enhancement to the invention to perform light functions, but clearly the sender

can be identified independent of the contact list as noted above. The Applicant's specification

even notes extracting a sender's identity form the header. In fact extracting the source

destination from the packet, frame, or cell is very well known. The Examiner respectfully notes

that in the absence of Novelty or Inventive step the claims are not Allowable over the prior art.

It appears that the Applicant is attempting to draw a distinction over the prior art by presenting a

method that operates by bypassing a contact list to correlate sender identities to previously

received messages. However, The Examiner respectfully disagree, simply eliminating the

reliance of the address book and using the extracted identity from the header is clearly covered in

the prior art as noted above. The contact list is used for received messages that operate in

conjunction with the illumination of the keypad, however the Hull reference explicitly teaches

that the sender can be identified based on the sender's identity extracted from the header and in

the absence of a contact being in the contact list the device is configured to allow the user to

access stored messages. Based on the above embodiment since the sender's id is not stored in

the contact list the keypad illumination function is suppressed and nothing more.

Therefore, the rejection is maintained as proper.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness
        or nonobviousness.

3.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hull et al. (US PAT.

No 20030034878) in view of FUJINO et al. (20010012347).

Regarding claim 1, Hull et al teaches a method of processing a communication event in a

mobile device (100, figure 1) having a user interface (103, 105, figure 1), the method comprising

of identifying a correspondent (sender's identity) associated with the communication event

(message, see page 2, paragraph (0019)), independent of address book (e.g., paragraphs 0023 and

0026), automatically retrieving (col. 2, paragraph (0046), lines 6-8) - allowing the user to access

stored message from a communication event database, a communication event history associated

with the identified correspondent (page 2, paragraphs (0026) & (0027))-where the user may send

or access message, the communication event history (message log, 213, figure 2) including a

plurality of prior communications events with the identified correspondent (page 2, paragraphs

(0019) & (0023)), the prior communications events including a plurality of event types (page 2,

paragraph (0023))., and displaying (103, figure 1) the retrieved communications event history of

the identified correspondent using the user interface (105, figure 1) of the mobile device (213,

214, figure 2, page 2, paragraphs (0023) & (0019)).

FUJINO et al teaches from a communication event database, a communication event history

associated with identified correspondent (page 3, paragraph (0034)).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time

the invention was made to modify Hull et al to include a plurality of prior communications

events with the identified correspondent, the prior communications events for the purpose of

giving the user the advantage to determine the context of the communication event (abstract).

Regarding claim 2, Hull et al discloses wherein the step of identifying where other related

data may store in the processing unit (Page 2, paragraph (0026)).

But, Hull et al does not specifically disclose where the limitation is preceded by the step

of determining a communication event type for the communication event.

However, FUJINO et al. teaches the preceding by the step of determining a communication event type for the communication event referring to a signal where the segment to the mobile device determine where the next segment is signaled to the mobile device (page 2 & 3, paragraph (0034).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Hull et al to determine how to identify the corresponding step without the communication event occurring for the purpose of handling a communication event in a mobile device.

Regarding claim 3, Hull discloses wherein the determined communication event type of the communications event is selected from a list including telephony based voice communication events (210, figure 2, page 3, paragraph (0028) & (0040)), e-mail communications events (page 2, paragraphs (0025) & (0040)), short messaging service communications event (page 2, paragraph (0025)) and wireless application protocol communications event (page 2, paragraph (0023)).

Regarding claim 4, Hull et al wherein the communications event is an incoming communications event (102, figure 1), and further including the step of receiving the incoming communications event (208, figure 2) prior to identifying the correspondent (page 2, paragraphs (0019) & (0026)).

Regarding claim 5, Hull et al. discloses wherein the plurality of event types include at least two of a telephony based voice communications event type (210 figure 2, page 3, paragraphs (0028) & (0040)), an e-mail communication event type (page 2, paragraphs (0025) &

(0040)), a short messaging service communications event type (page 2, paragraph (0025)) and a wireless applications protocol communications event type (page 2, paragraph (0023)).

Regarding claim 6, Hull et al discloses further including the step of adding the incoming communications event to the communications event history in the communications event database (209 figure 2, page 2, paragraphs (0023) & (0026)).

Regarding claim 7, Hull et al discloses wherein the step of receiving an incoming communications event includes one of: receiving a telephony based phone call (page 3, (0029)); receiving an incoming email message (page 2, paragraph (0025))., and receiving an incoming shod messaging service (SMS) message (page 2, paragraph (0025)).

Regarding claim 8, Hull et al discloses wherein the step of identifying the correspondent includes one of: extracting a phone number from call display information (page 3, paragraph (0028), extracting an email address from the header of an email message (page 3, paragraph (0028)), and extracting an originating address from a SMS message (page 3, paragraph (0028)).

Regarding claim 9, Hull et al discloses wherein the step of identifying further includes cross referencing one of the extracted phone number, the extracted email address, and the extracted originating address with entries in an address book accessible to the mobile device (418, figure 4, page 3, paragraph (0028)).

Regarding claim 10, Hull et al discloses further including a step of controlling the user interface to provide the user with communications event handling options (111, 127, figure 1, page 2 & 3, paragraph 10027)).

Regarding claim 11, Hull et al discloses wherein the step of controlling the user interface

includes providing the user an option to either ignore or answer an incoming telephony based

call (page 2 & 3, paragraph (0027J).

Regarding claim 12, Hull et al. further including the step of updating the communications

event database to reflect a status of the incoming call (page 4, paragraph (0040)).

Regarding claim 13, Hull et al discloses wherein the step of displaying communications

event handling options includes displaying the option to either read or ignore one of the

incoming email message and the incoming SMS message (page 5, paragraph (0055)).

Regarding claim 14, Hull et al discloses further including the step of updating the

communications event database to reflect the status of one of the incoming email message and

the incoming SMS message (page 5, paragraphs (0056) & (0057)).

Regarding claim 15, Hull et al discloses a mobile device, comprising: a transceiver for

transmitting and receiving communications events (102, figure 1)., a communications event

database for storing a plurality of communications event histories (110, figure 1), each of the

plurality of communications event histories being associated with one of the plurality of

correspondents (21 1, figure 2), a communications event handler for identifying a correspondent

in response to a communications event and for automatically retrieving the associated

communications event history for the identified correspondent (page 2, paragraphs (0019 &

(0026)) , independent of address book (e.g., paragraphs 0023 and 0026), and a user interface for

displaying the communications event history of the identified correspondent (page 2, paragraph

(0023)).

Regarding claim 16, Hull et al discloses wherein the communications event handler

includes a communications event type identifier for identifying the type of the communications

event from a list including telephony based voice communications events (page 3, paragraph

(0028)), e-mail communications events (page 3, paragraph (0028)), shod messaging service

communications event and wireless applications protocol communications event (page 2,

paragraph (0025)).

Regarding claim 17, Hull et al discloses wherein the user interface is a display, and the

communications event handler includes a display controller for controlling the display to display

the retrieved communications event history (111, figure 1, page 2 & 3, paragraph 10023)).

Regarding claim 18, Hull et al discloses wherein the communications event handler

includes a correspondent identifier for identifying the correspondent of an incoming

communications event (page 2, paragraph (0026)).

Regarding claim 19, Hull et al discloses wherein the correspondent identifier is connected

to the transceiver for receiving call display information (page 2, paragraph (0027)), and includes

means for identifying the correspondent of an incoming communications event based on the

received call display information (pages 3 & 4, paragraph (0038)).

Regarding claim 20, Hull et al discloses wherein the correspondent identifier includes an

address book interface for cross-referencing the received call display information with entries in

an address book accessible to the mobile device to identify the correspondent (page 3, paragraph

(0028), and pages 3 & 4, paragraph (0038)).

Regarding claim 21, Hull et al discloses wherein the correspondent identifier includes

header parsing means for parsing the header of one of a received email message and a received

SMS message to extract an originating address (page 3, paragraph (0035)), and includes means for identifying the correspondent of an incoming communications event based on the extracted originating address (page 3, paragraph (0028)).

Regarding claim 22, Hull et al discloses wherein the correspondent identifier includes an address book interface for cross referencing the extracted originating address with entries in an address book accessible to the mobile device to identify the correspondent (418, figure 4, page 3, paragraph (0028)).

Regarding claim 23, Hull discloses wherein the communications event handler includes a user interface controller for controlling the user interface to provide a user with communications event handling options (111, figure 1, pages 2 & 3, paragraph (0027)).

Regarding claim 24, Hull discloses wherein the communications event handler includes means for updating the communications event database to reflect the status of an incoming call (pages 2 & 3, paragraph (0027)).

Conclusion

4.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Charles Shedrick whose telephone number is (571)-272-8621.

The examiner can normally be reached on Monday thru Friday 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kincaid Lester can be reached on (571)-272-7922. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charles Shedrick
AU 2617

LESTER G. KINCAID
SUPERVISORY PRIMARY EXAMINER